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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/047,102	01/17/2002	Akira Date	500.37453CX2	6770

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EXAMINER

WENDMAGEGN, GIRUMSEW

ART UNIT PAPER NUMBER

2633

DATE MAILED: 06/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/047,102	<b>Applicant(s)</b> DATE ET AL.	
	<b>Examiner</b> Girumsew Wendmagegn	<b>Art Unit</b> 2633	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 January 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,4 and 5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4 and 5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. 09/369,401.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/6/2005, 7/7/2002, 6/20/2002, 1/17/2002</u> | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) The invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claim1, 4 and 5** are rejected under 35 U.S.C. 102(e) as being anticipated by Saeki et al. (patent number 6,078,727).

- ❖ **Claim1** drawn to a method for playing back a storage medium storing still picture group management information for managing still picture data. Said still picture management information includes a first and last recording time at which the still picture data in said still picture group was recorded, said method comprises receiving an entry of a predetermined time; comparing the predetermined time with first and last recording times and selectively playing back the still picture data belonging to said still picture group in which said predetermined time is equal to or later than first recording time and equal to or earlier than last recording time.

➤ Saeki et al. teaches a method for playing back a storage medium storing still picture group management information for managing still picture data. Said still picture management information includes a first and last recording time at which the still picture data in said still picture group was recorded; Said method comprises receiving an entry of a predetermined time; comparing the predetermined time with first and last recording times and selectively playing back the still picture data belonging to said still picture group in which said predetermined time is equal to or later than first recording time and equal to or earlier than last recording time **see column 12 line 5-17**

❖ **Claim 4 and 5** are drawn to a storage medium storing still picture group management information for managing still picture data as picture group. The still group management information includes a first and last recording time.

➤ Saeki et al. teaches storage medium storing still picture group management information for managing still picture data as picture group. The still group management information includes a first and last recording time. When storage medium receives a predetermined time; enables the apparatus to compare the predetermined time with the first and last recording time and selectively play back the still picture group belonging to said still

picture group satisfying the condition in which said predetermined time is equal or later than the first recording time and equal or earlier than the last recording time (**see column 11 line 40-67 and column 12 line 1-17**)

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

❖ **Claim 5** is rejected under 35 U.S.C. 101 because the claimed invention does not produce tangible result.

- A computer-readable storage medium storing procedure and information doesn't produce tangible result and not patentable unless it is executable. Only when a computer readable medium where the program when executed causes the computer to produce a useful, concrete and tangible result.
- Functional descriptive material claimed in combination with an appropriate computer readable medium to enable to functionality to be realized is patent eligible subject matter if it is capable of producing a useful, concrete and tangible result when used in the computer. **See cf. In re Warmerdam-data structure stored in a computer memory and In re Lowery, 32 USPQ2d 1031(F d.Cir.1994)**

- This rejection of claim5 may be obviated if applicant inserts the concept that the procedure is executable as presented on page 24 of the specification.

### ***Double Patenting***

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101, which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

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**Claim4 and 5** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim1 and 2 of copending Application No. 10/192,717. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter claimed in the instant application has obvious difference with the copending application No. 10/192,717.

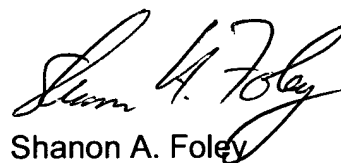
This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Girumsew Wendmagegn whose telephone number is 571-270-1118. The examiner can normally be reached on 7:30-5:00, M-F, alternate Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shanon Foley can be reached on 571-272-0898. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Girumsew Wendmagegn



Shanon A. Foley

Supervisory Patent Examiner